

PTO/SB/31 (09-04)

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**NOTICE OF APPEAL FROM THE EXAMINER TO  
THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Docket Number (Optional)

683

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]  
on \_\_\_\_\_

Signature \_\_\_\_\_

Typed or printed  
name \_\_\_\_\_

In re Application of  
Herbert Howell WADDELL

Application Number  
09/693,239

Filed  
October 20, 2000

For APPARATUS FOR GATHERING, PICKING UP AND CARRYING  
LOOSE MATERIALS

Art Unit  
3671

Examiner  
Pezzuto, Robert Eric

Applicant hereby **appeals** to the Board of Patent Appeals and Interferences from the last decision of the examiner.

The fee for this Notice of Appeal is (37 CFR 41.20(b)(1))

\$ 500.00

☒ Applicant claims small entity status. See 37 CFR 1.27. Therefore, the fee shown above is reduced by half, and the resulting fee is:

\$ 250.00

☐ A check in the amount of the fee is enclosed.

☐ Payment by credit card. Form PTO-2038 is attached.

☐ The Director has already been authorized to charge fees in this application to a Deposit Account. I have enclosed a duplicate copy of this sheet.

☒ The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. 50-1891. I have enclosed a duplicate copy of this sheet.

☐ A petition for an extension of time under 37 CFR 1.136(a) (PTO/SB/22) is enclosed.

**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒ attorney or agent of record.  
Registration number 36,479

☐ attorney or agent acting under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34. \_\_\_\_\_

Albert Wai Kit Chan  
Signature

Albert Wai-Kit Chan

Typed or printed name

(718) 357-8836

Telephone number

February 28, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below\*.

☒ \*Total of 2 forms are submitted.

This collection of information is required by 37 CFR 41.31. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Dkt. #683

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Herbert Howell Waddell  
U.S. Serial No.: 09/693,239 Examiner: Robert Pezzuto  
Filed : October 20, 2000 Art Unit: 3671  
For : APPARATUS FOR GATHERING, PICKING UP AND  
CARRYING LOOSE MATERIALS

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February 28, 2005

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir/Madam:

**NOTICE OF APPEAL FROM THE EXAMINER TO THE BOARD OF PATENT  
APPEALS AND INTERFERENCES AND COMMUNICATION IN RESPONSE TO  
NOVEMBER 29, 2004 FINAL OFFICE ACTION**

This Notice of Appeal and Communication is submitted in response to the November 29, 2004, a Final Office Action which was issued by the United States Patent and Trademark Office (USPTO) in connection with the above-identified application. The three-month shortened statutory period for reply is set to expire on February 29, 2005. However, because this is not a leap year, and thus, there is no February 29, 2005, a response to the November 29, 2004 Final Office Action is due February 28, 2005. Manual of Patent Examining Procedure, Section 710.01(a). Accordingly, this Notice of Appeal and Communication are timely filed.

Applicant hereby submit a Notice of Appeal and Communication in response to the November 29, 2004 Final Office Action issued by

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the USPTO in connection with the above-identified application. The Notice of Appeal from the Examiner to the Board of Patent Appeals and Interferences is attached herein as **Exhibit A** (1 page, in duplicate).

The required fee for a Notice of Appeal is TWO HUNDRED AND FIFTY DOLLARS (\$250.00) for a small entity. However, on December 29, 2003, Applicant already submitted a check in the amount of ONE HUNDRED AND SIXTY-FIVE DOLLARS (\$165.00), the required fee at the time for a Notice of Appeal. Accordingly, no fee for the Notice of Appeal is due since the required fee was already paid. 35 U.S.C. 134(a) ("An applicant for a patent . . . may appeal . . . having once paid the fee for such appeal.").

#### REMARKS

##### Response to rejection of Claims 1-3, 6-9, and 15 under 35

##### U.S.C. §102(b) as being anticipated by Davis '359.

Examiner states that "Claims 1-3, 6-9 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Davis '359" (Davis). Claim 1 is the sole independent claim, with Claims 2-3, 6-9, and 15 depending either directly or indirectly therefrom. Consequently, the claims rejected under this section will stand or fall together with Claim 1. Therefore, Claim 1 will be the focus of the analysis on this ground of rejection. Applicant respectfully traverses this ground of rejection for the reasons stated below.

To anticipate a claim, the reference must teach each and every

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element of the claim.

"A claim is anticipated only if each and every element as set forward in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 2USPQ2d 111051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the .... claim." Richardson v. Suzuki Motor Co., 9USPQ2d 1913, 1920 (Fed. Cir. 1989).

Claim 1 provides:

An apparatus for gathering, picking up and carrying materials comprising

- a) two grasping elements which each have shafts with grasping means at one end, and
- b) a flexible coupling means which can be moved along the shafts of the grasping elements to connect them together while permitting each of them to rotate along the axes of their shafts and to pivot with respect to each other so that the grasping heads can be brought together or moved apart from each other.

Davis discloses a post-hole digger which employs two grasping elements with shafts and grasping means (shovels) at one end. It also has a sliding clamp, which is fabricated from malleable iron. Applicant asserts that Davis cannot anticipate Claim 1, since Davis fails to disclose, *inter alia*, a "flexible coupling means." However, Examiner takes the position that "Webster defines 'malleable' as being flexible," and thus, the "malleable iron" clamp of Davis means that it is a "flexible" iron clamp, anticipating the flexible coupling means of Claim 1. Applicant respectfully disagrees.

It is improper to ascertain the true meaning of a term by looking only to the meaning of its individual components and

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then arriving at a definition by performing a mere summation of the meaning of its components. Here, Examiner looked at "malleable" in isolation of its surroundings and summarily assigned it a meaning without regard to context. The "malleable iron" of Davis is a term of art as opposed to an adjective (e.g., malleable) merely modifying a noun (e.g., iron). In other words, "malleable iron" is one term even though it consists of two words. With regard to materials, "malleable iron" is used to describe iron with a composition that permits it to be shaped by a hammer (or mallet, hence malleable), as compared with ordinary cast iron which can shatter when struck by a hammer. Since malleable iron is not brittle like some forms of iron, it was preferred in the time of Davis, and still is, for high impact uses, such as in hammers, pickaxes, and shovels. Therefore, it was the material of choice for Davis who needed a tough, hard, inflexible material for his shovels and for the clamp to join the shovels of his post-hole digger.

Webster's Third New International Dictionary of the English Language, Unabridged defines "malleable iron" as follows:

"Malleable iron, also malleable cast iron. n.: cast iron containing usually from 2 to 3 percent carbon and 1.5 to 0.8 percent silicon and produced by annealing white cast iron of this composition in order to convert hard brittle cementite to graphite in modular form so that the material will have greater ductility than white iron or ordinary gray iron containing graphite in flake form."

The USPTO recognizes malleable metal as a type of treated metal, such as iron; see the USPTO Patent Classification Glossary for Class 148, "Treated Metal". Additionally, the USPTO has recognized "malleable iron" as a distinct type of

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treated metal in issued patents, such as Ferra et al., Method of preparing high nodule malleable iron and its named product, US 6,024,804, Feb. 4, 2000, where various forms of iron are described in detail. A search of that issued patent reveals that the word "flexible" is not used once in the entire patent.

Based upon the foregoing, Applicant respectfully submits that the "malleable iron" clamp of Davis is hard and rigid, and cannot be considered flexible within the meaning of Claim 1. Davis uses a rigid clamp to firmly hold the specially shaped shafts of his device in the single configuration that is useful as a post-hole digger. When the device of Davis is assembled for use, the square shaft of one shovel is held in a square sleeve that forms one part of the coupling. The special crooked square shaft of the other shovel is held in another square sleeve, of which one side is closed by a metal rod, which permits this shovel to pivot in opposition to the other shovel. The square cross-section of the clamp sleeves prevents rotation of the shovels about the axes of their shafts when the clamp is in position to serve its useful purpose. Once the shovels are driven into the ground for digging, the clamp must be unyielding enough to enable leverage to be exerted on the pivoting handle to allow the shovels to break apart and grasp the displaced earth for removal. Thus, to function in its intended manner, the Davis device must have a rigid and unyielding clamp.

From the foregoing, it is clear that Davis lacks the "flexible coupling" element of Claim 1. Accordingly, since Davis fails to disclose every element of Claim 1, there cannot be any

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anticipation under 35 U.S.C. 102(b).

Nevertheless, Examiner additionally states that "Davis shows the coupling means being moveable along the grasping means shafts (as seen between figures 1 and 2) and because the top portions of the Davis handles are rounded, they can inherently rotate about their shaft axis while the coupling means is located at this rounded portion." Applicant respectfully disagrees.

Claim 1 provides a "coupling means which can be moved along the shafts of the grasping elements to connect them together *while* permitting each of them to rotate along the axes of their shafts *and* to pivot with respect to each other so that the grasping heads can be brought together or moved apart from each other." In contrast, the sliding clamp of Davis does not permit the handles there to rotate along the axes of their shafts *and* to pivot with respect to each other.

The sliding clamp of Davis only permits pivoting when it is situated at the bottom of the pivoting handle. And while the top rounded portion of the handles would allow both handles to rotate along the axes of their shafts when the sliding clamp is located in that portion, the handles would not be able to pivot to allow the spades to move together or apart. This is because the sliding clamp of Davis only permits movement of the pivoting arm in one, fixed direction. Consequently, when the sliding clamp is located in the top rounded portion of the handles, the handles have essentially no range of motion since they are permitted only one plane of motion and cannot move in a "scissor" motion past each other (like Applicant's

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invention) to allow the spades to be brought together or moved apart.

In light of the foregoing reasons, Applicant respectfully traverses this ground of rejection under 35 U.S.C. 102(b). Examiner fails to show how Davis anticipates every element of Claim 1. Accordingly, a rejection of Claims 1-3, 6-9, and 15 based on anticipation is improper.

**Response to rejection of Claims 1, 8, 9, 11, 12, and 15 under  
35 U.S.C. §102(b) as being anticipated by Lee '328**

Examiner states that "Claims 1, 8, 9, 11, 12 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Lee '328" (Lee). Claim 1 is the sole independent claim, with Claims 8, 9, 11, 12, and 15 depending either directly or indirectly therefrom. Consequently, the claims rejected under this section will stand or fall together with Claim 1. Therefore, Claim 1 will be the focus of the analysis on this ground of rejection. Applicant respectfully traverses this ground of rejection for the reasons stated below.

As stated in the previous section, "A claim is anticipated only if each and every element as set forward in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 2USPQ2d 111051, 1053 (Fed. Cir. 1987).

Lee discloses a device comprising two chopsticks that are connected at their outer ends by an elastic spring. However, Lee fails to disclose the "two grasping elements which each



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have shafts with *grasping means* at one *end*" of Claim 1. Claim 1 clearly states that the two grasping elements have shafts *and* grasping means at one end. Lee merely discloses the two chopsticks having only a shaft and no grasping means at one end.

In light of the foregoing reasons, Applicant respectfully traverses this ground of rejection under 35 U.S.C. 102(b). Examiner fails to show how Lee anticipates every element of Claim 1. Accordingly, a rejection of Claims 1, 8, 9, 11, 12, and 15 based on anticipation is improper.

**Response to rejection of Claims 1, 8, 9, and 11-15 under 35**  
**U.S.C. §102(b) as being anticipated by Laramie '663**

Examiner states that "Claims 1, 8, 9, and 11-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Laramie '663" (Laramie). Claim 1 is the sole independent claim, with Claims 8, 9, and 11-15 depending either directly or indirectly therefrom. Consequently, the claims rejected under this section will stand or fall together with Claim 1. Therefore, Claim 1 will be the focus of the analysis on this ground of rejection. Applicant respectfully traverses this ground of rejection for the reasons stated below.

As stated in the two previous sections, "A claim is anticipated only if each and every element as set forward in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 2USPQ2d 111051, 1053 (Fed. Cir. 1987).

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Laramie discloses a chopstick holder capable of holding a pair of chopsticks so as to facilitate their use. However, Laramie fails to disclose the "two grasping elements which each have shafts with **grasping means** at one **end**" of Claim 1. Claim 1 clearly states that the two grasping elements have shafts **and** grasping means at one end. Laramie merely discloses the two chopsticks having only a shaft and no grasping means at one end.

In light of the foregoing reasons, Applicant respectfully traverses this ground of rejection under 35 U.S.C. 102(b). Examiner fails to show how Laramie anticipates every element of Claim 1. Accordingly, a rejection of Claims 1, 8, 9, 11, 12, and 15 based on anticipation is improper.

Response to rejection of claims 4, 5, and 10 under  
35 U.S.C. §103(a) as being unpatentable over Davis '359 in  
view of Cox '484

Examiner states that "Claims 4, 5 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis '359 in view of Cox '484" (Cox). Claim 4 depends on independent Claim 1. Claim 5 further depends on dependent Claim 4. Claim 10 depends on Claim 8, which in turn, depends on Claim 1. Accordingly, Claims 4, 5, and 10 represent different embodiments of the claimed apparatus, and thus, include further limitations to independent Claim 1. Therefore, Claims 4, 5, and 10 stand alone. Applicant respectfully traverses the above-mentioned ground of rejection for the reasons stated below.

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The basis for all obviousness rejections is set forth under 35 U.S.C. § 103(a), which provides:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references (or references when combined) must teach or suggest all the claim limitations. Manual of Patent Examining Procedure, §2143.

Examiner states that "[i]t would have been obvious to one having ordinary skill in the art at the time of the invention to provide the device of Davis with the teachings of Cox in order to provide a grasping device having greater operational range (i.e., use for better grasping lawn debris, etc.)." The disclosure of Davis has already been discussed in the earlier section addressing Examiner's rejection under 35 U.S.C. §102(b). In that section, Applicant discussed how Davis fails to teach all the limitations of Claim 1.

As discussed *supra*, Davis fails to disclose "a *flexible*

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coupling means which can be moved along the shafts of the grasping elements to connect them together *while* permitting each of them to rotate along the axes of their shafts *and* to pivot with respect to each other so that the grasping heads can be brought together or moved apart from each other." Cox discloses two elongated handles which are connected at a central point by a pivot pin, with each handle having a fixed rake head. Thus, the coupling means (pivot pin) of Cox is neither flexible nor does it permit rotation of the handles along the axes of their shafts.

Accordingly, Davis and Cox, when combined, fail to teach all the limitations of Claim 1, and thus, necessarily fail to teach all the limitations of Claims 4, 5, 10 since these claims depend either directly or indirectly on Claim 1 and only include additional limitations. Therefore, Examiner has not satisfied this criteria of the *prima facie* case, and it is unnecessary for Applicant to address the remaining criteria of motivation to combine and reasonable expectation of success.

In light of the foregoing reasons, Applicant respectfully traverses this ground of rejection under 35 U.S.C. 103(a). Examiner has not fulfilled his burden of establishing a *prima facie* case of obviousness. Accordingly, a rejection of Claims 4, 5, and 10 based on obviousness is improper.

#### CONCLUSION

For the above reasons, Applicant respectfully requests that the above remarks be entered and made of record in the present application. An allowance is earnestly requested.

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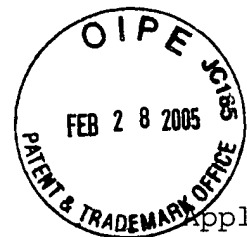
If a telephone interview would be of assistance in advancing the prosecution of the subject application, Applicant's undersigned attorney invites the Examiner to telephone him at the number provided below.

As discussed *supra*, no fee is deemed necessary in connection with the filing of this Notice of Appeal and Communication. However, if any additional fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 50-1891.

Respectfully submitted,

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U.S. Serial No. : 09/693,239 Examiner: Robert Pezzuto  
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February 28, 2005

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EXPRESS MAIL CERTIFICATE OF MAILING  
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